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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,544	08/29/2001	Joun Ho Lee	8733.497.00	4753
30827	7590	03/24/2004	EXAMINER	
MCKENNA LONG & ALDRIDGE LLP 1900 K STREET, NW WASHINGTON, DC 20006			RAO, SHRINIVAS H	
			ART UNIT	PAPER NUMBER
			2814	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,544

Applicant(s)

LEE, JOUN HO

Examiner

Steven H. Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 12-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

Applicants' amendment filed August 08, 2003 has been entered.

Therefore claims 1, 10 and 11 as amended by the amendment and claims 2-9 as previously recited are currently pending .

Non-elected Claims 12-19 are withdrawn from consideration.

Election/Restrictions

Applicant's election without traverse of claims 1-11 in Paper No. 08/08/ 2003 is acknowledged.

This application contains claims 12-19 drawn to an invention nonelected with traverse in Paper No. 08/08/2003.

A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 lines 6-7 recite, " a plurality of common electrodes and data electrodes configured to apply an electric field parallel to the first substrate to the liquid crystal layer " is not understood.

It is not clear if Applicants' want to claim the applied electric field is parallel to the first substrate and the liquid crystal layer or define the position of the first substrate with respect to other elements as was done in claim1 as originally filed.

Therefore Appropriate correction is required to clearly state what Applicants' intend to claim.

Dependent Claims 2-11 are rejected for at least depending from a rejected claim.

With respect to claim 10 the recitation , "the dummy pattern overlapping portion of the data line is electrically connected with the dummy pattern" is not understood because why would the dummy pattern that is overlapping the data line be electrically connected to itself ? .

The claim 10 as originally filed stated that the data line was electrically connected to dummy pattern which was understood.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

3A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 to 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Yokoyama et al. (U. S. Patent No. 6,144,435, herein after Yokoyama). (The previous rejection is reproduced below , for response to Applicants' arguments see section below).

With respect to claim 1, to the extent understood, Yokoyama describes an in-plane switching mode liquid crystal display device comprising: first and second substrates (Yokoyama et al. fig. 3 1a and b, col. 6 line 32); a liquid crystal layer between the first and second substrates (Yokoyama fig.3 # 13, col. 6 line 41); gate and data lines arranged to cross each other on the first substrate; (Yokoyama figs. 8 to 10)a plurality of common electrodes and data electrodes for applying an electric field parallel to the first substrate to the liquid crystal layer (Yokoyama figure 3 ,6,7 etc. , col. 6 line 37) ; and at least one dummy pattern overlapping at least one portion of the data lines.(Yokoyama fig. 13 A # 41, col.11 line 6).

The recitation, " for applying an electric field parallel to the first substrate to the liquid crystal layer "is taken to a product by process limitation and not given patentable weight. A product by process claim is directed to the product per se, (i.e. common and data electrodes) no matter how actually made . See In re Fessman, 180 USPQ 324, 326 (CCPA 1974) ; In re Marosi et al. 218 USPQ 289, 292 (Fed. Cir. 1983) and particularly In re Thrope , 227 USPQ 964, 966 (Fed. Cir. 1985), all of which make it clear that it is the patentability of the final structure of the product " gleaned" from the process steps, which must be determined in a " product by process" claim, and not the patentability of the

process. See also MPEP 2113. More ever , an old or obvious product produced by a new method is not a patentable product, whether claimed in “ product by process” claims or not. (similar to the previous rejection mailed 05/03/03 wherein patentable weight was not given to the phrase” for applying an electric field parallel to the first substrate within a pixel region defined by the gate and data lines).

Assuming Applicants' argue that the above recitation “ for applying an electric field parallel to the first substrate to the liquid crystal layer “ recites the use for the common and data electrodes , it is also well settled law that intended use does not differentiate from the prior art. See Ex parte Masham., 2USPQ 1647 (1987).

With respect to claim 2 to the extent understood Yokoyama describes the device as claimed in claim 1, further comprising a gate insulating film between the data line and the dummy pattern. (Yokoyama figure 3 # 5, col. 9 lines 20-27).

With respect to claim 3, to the extent understood Yokoyama describes the device as claimed in claim 1, wherein the dummy pattern overlaps first and second portions of the data line. (Yokoyama fig. 13 A).

With respect to claim 4 to the extent understood Yakoyama describes the device as claimed in claim 1, wherein the dummy pattern is integral with at least one of the common electrodes.(Yakoyama fig. 13 A # 41 ,31).

With respect to claim 5 to the extent understood Yokoyama describes the device as claimed in claim 1, wherein the dummy pattern includes a material the same as that of the common electrode. (Yokoyama col. 10 lines 6-7).

With respect to claims 6 and 7 to the extent understood Yokoyama describes the device as claimed in claim 1, wherein the dummy pattern includes a transparent conductive material. (Yokoyama col. 10 lines 6-7 and col. 9 lines 36-37-ITO).

With respect to claim 8 to the extent understood Yokoyama describes the device as claimed in claim 1, further comprising a common line in parallel to the gate lines. (Yokoyama fig. 13 A)

With respect to claim 9 to the extent understood Yokoyama describes the device as claimed in claim 8, wherein the common line is electrically connected with the plurality of common electrodes. (Yokoyama figure 27).

With respect to claim 10 to the extent understood Yokoyama describes the device as claimed in claim 1, wherein the dummy pattern overlapping portion of the data line is electrically connected with the dummy pattern. (Yokoyama col. 5 lines 1-6).

With respect to claim 11 to the extent understood Yokoyama describes the device as claimed in claim 4, wherein a portion of at least one of the common electrodes integral with the dummy pattern is electrically insulated from the common line. (Yokoyama figure 29).

Response to Arguments

Applicant's arguments filed 8/8 2003 have been fully considered but they are not persuasive for the following reasons :

Applicants' first contention that the applied Yokoyama reference fails to teach or suggest , " a plurality of common electrodes and data electrodes configured to apply an electric field parallel to the first substrate to the liquid crystal layer " is not understood for reasons stated under the 112(2) rejection set out above.

To the extent understood, Yokoyama in figures 5C 6a and 13 A etc. and col. 10 lines 1-20 describes " a plurality of common electrodes and data electrodes configured to apply an electric field parallel to the first substrate to the liquid crystal layer " .

Therefore claim 1 is not distinguished over the applied art .

Dependent claims 2-11 were alleged to be allowable because of their dependency from allegedly allowable claim 1 .

However as shown above claim 1 is not allowable. Therefore claims 2-11 are also not allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven H. Rao whose telephone number is (571) 272-1718 . The examiner can normally be reached on 8.00 to 5.00.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 3067722.



Steven H. Rao

Patent Examiner

February 19, 2004.


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